

### **REMARKS**

Claims 2-27 and 29-58 are pending. Claim 34 was amended as discussed below. Fig. 1 was amended as discussed below.

No new matter was added by any of the amendments. The revised language in claim 34 and the amendments to Fig. 1 are fully supported by at least paragraphs [00021], [00027] and [00028] of the original specification. These text portions clearly describe that there is a processor within the client machine that is used to conduct the performance tests on the groups of network configuration settings, and that the network configuration settings are stored in the remote server 105 and/or the client machine 115.

Withdrawal of all outstanding rejections is respectfully requested for at least the reasons set forth below.

### **Request for Interview Prior to Formal Action on Amendment**

Applicants request an interview prior to formal action on this response. An “Applicant Initiated Interview Request Form” accompanies this response. Please contact Applicants’ undersigned representative to schedule the interview.

### **35 U.S.C. § 101 rejection**

The article of manufacture claims were rejected under 35 U.S.C. § 101 as allegedly being non-statutory. In the paragraph numbered 8 of the Office Action, the Examiner stated that this rejection can be overcome by reciting a “processor” and “memory.” Accordingly, claim 34 was amended to explicitly recite using a “processor” to perform steps (d) and (f), and holding the network configuration settings in “storage.” The noun “storage” was selected instead of “memory” because it more closely matched the language of the original specification which refers to the verb of “stored” and “stores.” Network configuration settings that are stored inherently require “storage.” In view of this amendment, withdrawal of this rejection is respectfully requested.

### **Prior art rejections**

Claims 2-3, 5-12, 14, 18, 23, 26, 27, 29-30, 32-39, 41, 45, 50 and 53-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claessens et al. (hereafter, "Claessens") in view of Rehkopf.

Claims 4 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claessens et al. in view of Rehkopf and Official Notice.

These rejections are respectfully traversed for at least the reasons set forth below.

### **SECTION I: REFILED "DECLARATION OF PRIOR INVENTION"**

#### **1. Applicants' concurrently refiled "Declaration of Prior Invention..." under 37 C.F.R. § 1.131 overcomes the outstanding rejection**

All of the grounds of the outstanding rejection include Claessens. Claessens has a filing date of February 28, 2001 which is prior to the February 19, 2002 filing date of the present application and also prior to the priority document of the present application, namely, U.S. Provisional Application No. 60/277,463 filed on March 21, 2001. However, the invention set forth in the present application was conceived prior to February 28, 2001 as established in the concurrently filed "Declaration of Prior Invention..." under 37 C.F.R. § 1.131 (hereafter, "the Declaration"), and due diligence from prior to February 28, 2001 to the effective filing date of the present application (constructive reduction to practice), which is March 21, 2001 (the filing date of U.S. Provisional Application No. 60/277,463) is also established in the Declaration. A summary of the events established in the Declaration is provided as follows:

1. On February 15, 2001, which is prior to the effective filing date of Claessens, a technical disclosure (Exhibit 1) was created that contained sufficient evidence of conception of the presently claimed invention, as shown in the claim chart of Exhibit 4.

2. Due diligence towards a constructive reduction to practice began at least as early as February 22, 2001, which is also prior to the effective filing date of Claessens, when the invention disclosure was forwarded to Applicants' undersigned representative.

3. Due diligence towards a constructive reduction to practice continued throughout March 2001, culminating in the filing of U.S. Provisional Application No. 60/277,463 on March 21, 2009.

Furthermore, since U.S. Provisional Application No. 60/277,463 includes all of the disclosure items of Exhibit 1 that were highlighted in Exhibit 4, the present application is entitled to the priority date of the provisional application.

The evidentiary materials provided in the Declaration are fully compliant with the requirements of MPEP 715 for a showing of a “prior invention” (swearing back of a reference). More specifically, the evidentiary materials provide a showing of facts of “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice),” as discussed in MPEP 715.07, Part III, paragraph (C) and MPEP 715.07(a), attached hereto as an Appendix.

Accordingly, withdrawal of all outstanding prior art rejections is respectfully requested regardless of whether the arguments presented in sections 3-8 below are persuasive in overcoming the prior art rejections.

2. The refiled “Declaration of Prior Invention...” addresses all of the deficiencies highlighted in the outstanding Office Action

On page 13 of the outstanding Office Action, the Examiner highlighted two deficiencies in the previously filed Declaration, namely, that it was not signed by “all inventors” and that it did not adequately highlight where steps (c) and (e) of the independent claims are disclosed in Exhibit 1. The refiled Declaration is believed to fully address both of these deficiencies.

First, the refiled Declaration is signed by “all inventors.

Second, the Exhibit 4 claim chart of the refiled Declaration now highlights an additional portion of Exhibit 1 that was inadvertently not highlighted in the previous Declaration, namely, the text portion on Page 11, Active Learning Algorithm which reads as follows (underlining added for emphasis):

The Active Learning Algorithm is designed to determine a baseline for network performance on the client computer. Using a series of connectivity tests, performance metrics will be obtained and stored on the client computer. The Active Learning Algorithm will perform these tests with a variety of network setting configurations in order to record accurate performance metrics. The Intelligent Optimization Algorithm may later use these metrics, if the user prefers to be connected to the Internet using Active mode.

In conjunction with the other highlighted portions of Exhibit 1, it is clear that Exhibit 1 disclosed the claimed steps (c) and (e), that is, a plurality of groups of network configuration settings were

tested, not just one group of network configuration settings. See, for example, the excerpted text portion above which refers to a “series of connectivity tests” performed with a “variety of network setting configurations.”

In view of the discussion above, withdrawal of the prior art rejections is respectfully requested.

## **SECTION II: Substantive response to outstanding rejections**

### **1. Claessens**

Claessens discloses a system and method for network performance testing. This has nothing to do with the claimed invention which relates to optimizing network configuration settings for a user's client machine, not a network, by adjusting network configuration settings of the user's client machine. Claessens does not even discuss any element equivalent to a user client machine that is configured to have its network configuration settings adjusted. At best, column 7, line 65 through column 8, line 14 of Claessens discusses a web server/user interface 310 that functions to control the network performance testing. However, no adjustments are made to the network configuration settings of the user interface device 310. Thus, Claessens is not relevant to the claimed invention and fails to disclose or suggest any of the claimed steps.

As highlighted by the Examiner, Claessens discloses test configuration data and stores a plurality of different test configurations. As discussed on column 10, lines 15-24 of Claessens, each test configuration has a predetermined identifier that is associated with network-related parameters such as a predetermined packet rate, packet size, test duration, packet generators, packet receivers and one or more devices to be tested. As further discussed in column 10, lines 33-60 of Claessens, a system administrator selects one of the plurality of test configuration identifiers. The network is then configured based on the network-related parameters associated with that identifier, and a network performance test is conducted using the configured network. Thus, at best, Claessens discloses providing a plurality of groups of network-related parameters for configuring a network. In contrast to Claessens, the claimed invention recites providing a plurality of groups of network configuration settings for a user's client machine.

The Examiner admits that Claessens does not disclose providing “settings to be used by the user's client machine” as required by steps (a) and (c) of claims 7 and 34, and that Claessens does not disclose steps (e) or (f) of claims 7 and 34.

## 2. Rehkopf

Rehkopf discloses a method for benchmarking and optimizing end-to-end processing performance of a computer network system. The method operates as follows:

- a. System performance variables are selected.
- b. A baseline performance test is run using an initial set of values for the system performance variables to produce a benchmark system performance.
- c. The system performance variables are fixed at the initial set of values.
- d. A floating variable is selected from among the system performance variables.
- e. Subsequent tests are run with the floating variable set to different values, and system performance indicators that result from each subsequent test are recorded. The system performance indicators are compared to the benchmark system performance. An optimal value of the floating variable is then recorded that optimizes the system performance indicators.
- f. Another floating variable is then selected from among remaining system performance variables that have not yet been selected to be the floating variable.
- g. Steps (e) and (f) are repeated until all of the system performance variables have been selected as the floating variable.
- h. Each of the system performance variables are then fixed to its optimal value.

Rehkopf's method can be characterized as a "brute force" method in that each system performance variable is individually tested while keeping the other system performance variables constant. (The system performance variable being tested during each iteration is the "floating variable.")

Rehkopf's method has at least the following disadvantages:

- a. The test process may take a long amount of time because each system performance variable must be individually tested throughout its entire potential range of values. If there are a large number of system performance variables, the test time may be extremely long.
- b. After each system performance variable is individually tested, its "optimal value" is determined only in view of the initial values of the other system performance variables (which remain fixed at their initial values during the testing). However, it is very common that certain system performance variables affect other system performance variables. Thus, each system performance variable may actually have a better (i.e., more optimal) value if one or more of the

other system performance variables were set to a value other than their initial values. Rehkopf's method has no process for determining the best set of system performance variables.

c. No prior knowledge of previously determined optimal system performance variables is used in Rehkopf. Such knowledge could potentially speed up the testing process by reducing or eliminating the number of system performance variables that would need to be tested, or by reducing the range of values to be tested for the current floating variable.

3. Patentability of amended independent claims 7 and 34 over Claessens in view of Rehkopf

Claim 7 reads as follows:

7. A method of optimizing network configuration settings for a user's client machine, the method comprising:

- (a) providing a plurality of groups of network configuration settings to be used by the user's client machine;
- (b) establishing a network connection between the user's client machine and a remote server;
- (c) selecting one of the groups of network configuration settings to be used by the user's client machine from the provided groups of settings, wherein step (c) is initiated on the user's client machine;
- (d) automatically conducting one or more performance tests using the selected network configuration settings during the established network connection;
- (e) repeating steps (c) and (d) for one or more other groups of network configuration settings during the established network connection; and
- (f) automatically adjusting the network configuration settings of the user's client machine provided in the groups based on the results of the performance tests, wherein the adjusted network configuration settings are settings that optimize the performance of the user's client machine.

**The combination of Claessens in view of Rehkopf does not meet any of the six recited steps.**

In the outstanding Office Action, the Examiner asserts that steps (a)-(c) are met by Claessens, except for providing "settings to be used by the user's client machine" as required by steps (a) and (c), and steps (d) and (e). As discussed above, Claessens relates to network performance testing which has nothing to do with the claimed invention which relates to optimizing network configuration settings for a user's client machine, not a network, by adjusting network configuration settings of the user's client machine. Nonetheless, the Examiner asserts

that an artisan would have found it obvious to modify Claessens in view of Rehkopf, and that the modified version of Claessens would provide all of the features missing from Claessens, namely, the use of settings for the user's client machine, as well as the missing steps (d) and (e).

Applicants respectfully disagree, and assert that even if Claessens was modified in view of Rehkopf as suggested by the Examiner, the resultant modified Claessens would still lack all of the steps in claim 7.

In the outstanding Office Action, the Examiner relies upon Rehkopf as disclosing concepts similar to steps (d) and (e) of claims 7 and 34, and asserts that it would have been obvious to modify Claessens to incorporate the features of these steps. That is, the Examiner's position appears to be that it would have been obvious to modify Claessens to conduct one or more additional network performance tests using parameters from different groups of network-related parameters for configuring a network (i.e., different test configuration identifiers) in Claessens). Applicants respectfully traverse this position.

First, Rehkopf does not disclose selecting a different group of performance variables. In the iterative step (g) of Rehkopf discussed in section 2 above, another floating variable is selected from among remaining system performance variables that have not yet been selected to be the floating variable, and the remaining variables are set or reset to their initial values. If the initial set of values (or a subset of the initial set of values) is considered to be equivalent to the claimed group of network configuration settings, at best, Rehkopf discloses providing only one group of network configuration settings. Rehkopf always reverts back to the same initial set of values (i.e., the same group of network configuration settings) every time that the floating variable is changed. Thus, the concept of providing a plurality of groups of network configuration settings and conducting performance tests on the different groups of provided network configuration settings is completely absent from Rehkopf.

At best, modifying Claessens in view of Rehkopf would result in performing network performance tests by modifying only one of the parameters associated with the one selected test configuration identifier (Claessens only selects one test configuration identifier), and then repeating the network performance tests by modifying another (different) parameter in the one selected test configuration identifier. For example, the first test may vary the packet rate and the second test may vary the packet size. The parameters that are not being modified would remain at their initial values, exactly as disclosed by Rehkopf. There is simply nothing in Rehkopf to

suggest modifying Claessens so that a different test configuration identifier (and thus a different group of parameters) would be selected for subsequent testing.

Stated simply, Rehkopf does not disclose the concept of conducting subsequent performance tests using a different group of settings. Therefore, Rehkopf cannot make up for the above-noted deficiencies in Claessens, and thus even if Claessens was modified as suggested by the Examiner, the resultant modified Claessens would still lack at least the above-highlighted features in steps (d) and (e), as well as step (f) of claim 7. To summarize, Applicants are not asserting that Claessens cannot be modified based on disclosures in Rehkopf. Instead, Applicants are asserting that the modifications suggested by Rehkopf would not lead to Applicants' claimed invention.

Second, Claessens relates to network performance testing which has nothing to do with the claimed invention which relates to optimizing network configuration settings for a user's client machine, not a network, by adjusting network configuration settings of the user's client machine. Thus, even if Claessens was modified in view of Rehkopf as proposed by the Examiner, the resultant modified Claessens would still not meet any of the claimed steps which all relate to network configuration settings of a user's client machine. Furthermore, even if Claessens was modified in view of Rehkopf to cause the selection of a different test configuration identifier (and thus a different group of parameters) for subsequent testing, the resultant modified Claessens would still not meet any of the claimed steps which all relate to network configuration settings of a user's client machine. Of course, Applicants do not believe that this latter modification is suggested by the references, but this point illustrates just how different the applied references are from the claimed invention.

Claim 34 is believed to be patentable over Claessens in view of Rehkopf for the same reasons as claim 7.

#### 4. Applicants' comments regarding Examiner's Response to Arguments (paragraph numbered 7 of outstanding Office Action)

Applicants respectfully request that the Examiner reconsider the arguments above because **Claessens in view of Rehkopf does not meet *any* of the six recited steps of the independent claims 7 and 34.** It is clearly erroneous to maintain a rejection that does not even meet one step of a claimed process, especially when there are six recited steps.



Furthermore, the response to Applicants' arguments provided in the paragraph numbered 7 of the outstanding rejection does not provide any substantive explanation of why Applicants' arguments are not persuasive.

The Examiner merely states that Applicants are attacking the references individually where the rejections are based on combinations of references. Applicants respectfully disagree with this characterization of the arguments. Applicants' arguments exactly track the manner in which the references were applied by the Examiner. In fact, Applicants stated above that they are not asserting that Claessens cannot be modified based on disclosures in Rehkopf, but instead are asserting that the modifications suggested by Rehkopf would not lead to the claimed invention. This is not an attack on the references individually where the rejections are based on combinations of references.

The Examiner also provides a new rationale for the combination rejection as follows:

The different groups of configuration settings are found in Claessens, while the repetition of testing settings is found in Rehkopf. As the applicant points out, every time the floating variable is changed Rehkopf tests that new setting. The combination of Claessens and Rehkopf teaches optimizing (which is specifically shown in Rehkopf) network configuration settings.

As best as this new rationale is understood by Applicants, it appears to be premised on the fact that Rehkopf is only being used for the idea of repeating different test settings, and not for any particular technique to obtain the different test settings (e.g., Rehkopf's "brute force" methodology described above). Thus, even though Claessens discloses only the storage of a plurality of different test configurations, and the selection and use of only one of the plurality of different test configurations (i.e., no repetition of testing settings), the Examiner appears to be asserting that Rehkopf can be used to modify Claessens to provide for the repetition of testing settings, which would be a different Claessens test configuration, and wherein the different test configurations would be equivalent to the claimed different group of network configuration settings. That is, as best as this rationale is understood by Applicants, Rehkopf's "brute force" methodology would not be used at all in Claessens, and the concept of the different group of network configuration settings would be taken from Claessens, not Rehkopf.

This new rationale also fails to provide a legally sufficient rationale for an obviousness rejection because if Claessens is modified based on Rehkopf to include repeatability of its different test configurations to identify an optimum test configuration, Claessens would still not be optimizing test configurations for a user's client machine, but instead would only be optimizing test configurations for a network. As previously discussed above, and as admitted by the Examiner, Claessens lacks the claimed feature of optimizing network configuration settings for a user's client machine. If the Examiner's position is that Rehkopf can be used for the "repetition of testing" feature and for the use of a "user's client machine," but without Rehkopf's "brute force" methodology, then this new rationale is clearly an improper attempt to "dissect claims and reconstruct them in piecemeal fashion by picking and choosing from among the prior art references using the patent as a blueprint." *In re Kamm*, 452 F.2d 1052, 1056-57, 172 USPQ 298, 301-02 (CCPA 1972). Here, the Examiner appears to be selecting only the concept of "repetition of testing" from Rehkopf, while improperly ignoring, and not using, Rehkopf's actual disclosure of how repeated testing is performed.

In sum, the response to arguments in the outstanding rejection fail to properly rebut Applicants' arguments for patentability.

#### 5. Patentability of dependent claims

The dependent claims are believed to be patentable over the applied references for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps.

### **Conclusion**

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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# APPENDIX

715.07

## MANUAL OF PATENT EXAMINING PROCEDURE

nation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

### II. ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

### III. THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) >(actual)< reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence

from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).



A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection.

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

For the most part, the terms "conception," "reasonable diligence," and "reduction to practice" have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.131] affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. *In re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); *In re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Form paragraph 7.59 or 7.63 (both reproduced in MPEP § 715) may be used where insufficient evidence is included in a 37 CFR 1.131 affidavit.

### 715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).